APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,219	12/05/2000	Ghassan Chidiac	YOR920000746US1	9167

7590 11/16/2004	EXAMINER
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ART UNIT	PAPER NUMBER
2161	10

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 June 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1, 5, 12, 16, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by

U.S. Patent No. 5,608,874 to Ogawa et al. (hereafter Ogawa '874).

Claim 1:

Regarding Claim 1, Ogawa '874 discloses: a method for selecting a file format from a

plurality of stored file formats for use in performing a translation from said selected file format

to a requested file format (Ogawa '874: Abstract), the method comprising the steps of:

-      receiving a request for a data file in a requested format (Ogawa '874: col. 33, ln. 48 to

       col. 34, ln. 59);

-      determining an optimal file format from a plurality of stored files for use in performing

       said translation to said requested file format (Ogawa '874: col. 34, lns. 60-64); and

-      translating the optimal file format of said date file determined in said determining step to

       the requested file format (Ogawa '874: col. 34, lns. 60-64).

Claim 5:

Regarding Claim 5, Ogawa '874 discloses all the limitations of Claim 1 (supra). Further

note that Ogawa '874 discloses: wherein said determining step further includes the step of

consulting an optimized list of file formats from which to perform said translation of said stored

data file to the requested file format (Ogawa '874: col. 16, lns. 18-23). Note that the

"Subscriber Translation Information" of Ogawa '874 reads on an optimized list of file formats.

Claims 12 and 16:

Claims 12 and 16 are the apparatus embodiment of Claims 1 and 5 respectively and are

rejected on the same basis.

Claim 23:

Regarding Claim 23, Ogawa '874 discloses: an apparatus for selecting a file format from

a plurality of stored file formats for use in performing a translation from said selected file format

to a requested file format, said apparatus comprising:

- an interface for receiving a request for a data file in a requested format (Ogawa '874: col.

    12, lns. 1-10; col. 13, lns. 8-13; and col. 22, lns. 4-13); and

- a translation optimization logic coupled to said interface for determining an optimal one

    of a plurality of file formats for use in performing said translation to said requested file

    format (Ogawa '874: col. 33, ln. 48 to col. 34, ln. 64).

3.   Claims 1-5, 7-8, 12-16, 18-19, and 23 are rejected under 35 U.S.C. 102(e) as being

anticipated by U.S. Patent No. 6,549,918 to Probert et al. (hereafter Probert '918).

Claim 1:

Regarding Claim 1, Probert '918 discloses: a method for selecting a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format (Probert '918: Abstract), the method comprising the steps of:

- receiving a request for a data file in a requested format (Probert '918: col. 13, lns. 16-28); and

- determining an optimal file format from a plurality of stored files for use in performing said translation to said requested file format (Probert '918: col. 13, lns. 28-34; col. 3, lns. 18-25).

Claims 2-5:

Regarding Claims 2-5, Probert '918 discloses all the limitations of Claim 1 (supra). Further note that Probert '918 discloses:

- (Claim 2) wherein said determining step is based upon minimizing data loss from said translation (Probert '918: col. 4, lns. 16-25).

- (Claim 3) wherein said determining step is based upon minimizing the file size of the translated data file (Probert '918: col. 4, lns. 16-25).

- (Claim 4) wherein said determining step is based upon the requested file format and the available stored file formats (Probert '918: col. 4, lns. 16-25; col. 4, lns. 35-40).

- (Claim 5) wherein said determining step further includes the step of consulting an optimized list of file formats from which to perform said translation of said stored data file to the requested file format (Probert '918: col. 10, lns. 31-34).

<u>Claims 7-8:</u>

Regarding Claim 8, Probert '918 discloses all the limitations of Claim 5 (supra). Further

note that Probert '918 discloses:

- (Claim 7) wherein said optimized list is consulted if the stored data file is stored in a

  plurality of formats (Probert '918: col. 10, lns. 31-34; and additionally col. 4, lns. 47-57;

  col. 8, ln. 60 to col. 9, ln. 18). Note that the Native Structured Storage (NSS) of Probert

  '918 is a data file stored in a plurality of formats.

- (Claim 8) wherein said consulting step further includes selecting one of said optimized

  list from a plurality of said optimized lists (Probert '918: col. 10, lns. 31-34). Note that

  Probert '918 discloses storing an optimized list on a per-file basis. Thus Probert '918 is

  disclosing storing multiple optimized lists, and chooses an optimized list that matches a

  file to be converted.

<u>Claims 12-16 and 18-19:</u>

Claims 12-16 and 18-19 are the apparatus embodiment of Claims 1-5 and 7-8

respectively and are rejected on the same basis.

<u>Claim 23:</u>

Regarding Claim 23, Probert '918 discloses: an apparatus for selecting a file format from

a plurality of stored file formats for use in performing a translation from said selected file format

to a requested file format, said apparatus comprising:

- an interface for receiving a request for a data file in a requested format (Probert '918:

  col. 13, lns. 18-27); and

- a translation optimization logic coupled to said interface for determining an optimal file

  one of a plurality of file formats for use in performing said translation to said requested

  file format (Probert '918: col. 3, lns. 18-25).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 6, 9-11, 17, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Probert '918 in view of U.S. Patent No. 5,613,124 issued to Atkinson et al. (hereafter

Atkinson '124).

Claim 6:

Regarding Claim 6, Probert '918 discloses all the limitations of Claim 5 (supra).

However, Probert '918 does not explicitly disclose: wherein said list is indexed by said requested

file format.

Atkinson '124 discloses Structured Storage (TM), distributed by Microsoft Corporation

(TM) a well known means of persisting data having a variety of formats into a single object

persistence file. Specifically, Atkinson '124 discloses: wherein said list is indexed by said

requested file format (Atkinson '124: col. 17, lns. 49-66; col. 14, lns. 8-23). Note that the

"enumerator of formatetcs" of Atkinson '124 reads on a format type list indexed by requested

file format.

It would have been obvious to a person having ordinary skill in the art to apply the

indexed list of Atkinson '124 to the method of Probert '918. The motivation to accomplish said

application is suggested by Probert '918 which discloses the use of Structured Storage (TM) as

part of the method (Probert '918: col. 8, ln. 60 to col. 9, ln. 13).

Claim 9:

Regarding Claim 9, Probert '918 discloses all the limitations of Claim 8 (supra).

However. Probert '918 does not explicitly disclose: wherein the ordering of said optimized lists

is based on criterion regarding the translation to be performed on the stored data file.

Atkinson '124 discloses: wherein the ordering of said optimized lists is based on a

criterion regarding the translation to be performed on the stored data file (Atkinson '124: Fig. 4;

col. 6, lns. 20-41; col. 17, lns. 28-38). Note that the "enumerator of formatetcs" of Atkinson

'124, is implementation specific and thus reads on being based on a criterion regarding the

translation to be performed on the stored data file.

It would have been obvious to a person having ordinary skill in the art to apply the

indexed list of Atkinson '124 to the method of Probert '918. The motivation to accomplish said

application is on the same basis as Claim 6 (supra).

Claim 10:

Regarding Claim 10, Probert '918 and Atkinson '124 in combination disclose all the

limitations of Claim 9 (supra). Further note that Probert '918 and Atkinson '124 in combination

disclose: wherein said criterion is defined by a request for said date file (Atkinson '124: Fig. 4;

lns. 20-41; col. 17, lns. 28-38). Note that the "enumerator of formatetcs" of Atkinson '124, is

implementation specific and thus reads on being based on a criterion defined by the received

request.

Claim 11:

Regarding Claim 11, Probert '918 and Atkinson '124 in combination disclose all the

limitations of Claim 6 (supra). Further note that Probert '918 an Atkinson '124 in combination

disclose: the method further comprising the steps of:

- accessing a portion of said optimized list ordered based upon the requested file format;

    determining whether one or more of said listed file formats exists as one of said stored

    file formats (Probert '918: col. 10, lns. 31-34); and

- selecting from said optimized list the optimal file format that is determined to exist as a

    stored file format (Probert '918: col. 10, lns. 31-34).

Claims 17 and 20-22:

Claims 17 and 20-22 are the apparatus embodiment of Claims 6 and 9-11 respectively

and are rejected on the same basis.

Response to Arguments

6.   Applicant's arguments filed July 22, 2004 have been fully considered but they are not

persuasive. Applicant's arguments are addressed as follows:

A.   Applicant argues that Ogawa '874, "does not teach a 'plurality of stored file

formats,' and further that Ogawa '874 does not teach, 'a selection of an optimal

file format.'" (Amendment: p. 2, lns. 21-22 and ln. 19).

Examiner points out that Ogawa '874 discloses, "A unique system for

automatically selecting and implementing specific translation modules may be

used." (Ogawa '874: col. 2, lns. 59-61). Thus, in fact, Ogawa '874 discloses

storage of multiple file formats, as embodied in the translation modules, and

discloses selection of a translation module.

Additionally, Examiner notes that MPEP § 2131.02 states, "A Species Will

Anticipate a Claim to a Genus." Ogawa '874 does disclose implementing an

intermediate format, but use of an intermediate format renders Ogawa '874 as a

specific means of determining and optimal file format and translating. Therefore,

use of an intermediate format, does not change the Ogawa '874 anticipating

Applicant.

B.   Applicant argues that Probert '918 does not disclose "pre-stored versions of the

desired data file in different formats."

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant

relies (i.e., "pre-stored versions of the desired data file in different formats.") are

not recited in the rejected claim(s). Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Claims, as currently written, state, "selecting a file format from a plurality of

stored file formats" (Amendment: p. 5, claim 1, lns. 2-3), and "stored file

formats of said data file" (Amendment: p. 5, claim 1, lns. 6-7). Examiner's

reading makes some specific distinctions:

-	File	This reads on a data manifestation itself.
-	File format	This reads on the actual storage convention for a file.
-	"A file stored in a file format"	This reads on a file translated into a particular file format by a translation module (Ogawa '874: col. 2, lns. 59-61) or a file conversion driver (Probert '918: col. 10, ln. 31).

Thus the phrase, "selecting a file format from a plurality of stored file formats"

(Amendment: p. 5, claim 1, lns. 2-3) read on selecting a convention, or selecting

a translation module / file conversion driver. If the claims were to read, "selecting

a version of a file from a plurality of pre-stored versions of the file in different

formats," Examiner believes the claims would more closely capture Applicant's

invention.

Examiner notes that Probert '918 also anticipates storing a version of the file from

a plurality of stored versions of the file in different formats (Probert '918: col. 10,

lns. 30-32). These stored versions of the file are the result of caching, rather than

a priori, pre-storage of file formats. However, the claims recite, "a plurality of

stored file formats" rather than, "a plurality of pre-stored file formats."

For the above reasons, Examiner finds that Applicant's claims, as currently

written, do not recite the features that Applicant uses to distinguish from the prior

art.

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Patrick J.D. Santos whose telephone number is 571-272-4028.

The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick J.D. Santos
November 12, 2004

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